

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Graczyk et al.

Application No: 10/509,128

Group Art Unit: 1626

Filed: July 28, 2005

Examiner: Loewe, Sun Jae Y.

For: Azaindoles as Inhibitors of C-JUN N-Terminal Kinases for Treatment of
Neurodegenerative Disorders

Attorney Docket No: 102286.154US1

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT AND
REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §§ 1.702-1.705

Dear Sir:

The Notice of Allowance mailed on October 7, 2008 for the application referenced above recites a 164 day patent term adjustment. Applicants believe that the application is entitled to more than 164 days of term adjustment, and hereby request reconsideration of the patent term adjustment as follows.

Applicants believe the total patent term adjustment under 37 C.F.R. §§ 1.702-1.704 should be the total of:

(1) 164 days under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1), as recognized in the Notice of Allowance, for the Patent Office delay in issuing a first office action 14 months after the filing date minus any Applicants' delay; and

(2) the total number of days (205 days as of February 18, 2009) under 37 C.F.R. §§ 1.702(b) and 1.703(b) for the Patent Office delay in issuing the patent after July 28, 2008 (three years from the filing date) until the actual issue date of the patent (to be determined).

The periods (1) and (2) are believed not to overlap under 37 C.F.R. § 1.703(f). *See Wyeth v. Dudas*, 88 U.S.P.Q.2d 1538 (D.D.C. 2008). Thus, as of February 18, 2009, the total adjustment based on (1) and (2) above would be 369 days, but this is subject to recalculation depending on the actual issue date of the patent.

The additional days of patent term adjustment are requested under 37 C.F.R. §§ 1.702(b) and 1.703(b) for the following reason.

37 C.F.R. 1.702(b) states:

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a)

The instant application was filed under 35 U.S.C. § 111(a) on July 28, 2005 and therefore should have issued by July 28, 2008.

37 C.F.R. § 1.703 states in pertinent part:

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) ... and ending *on the date a patent was issued* (emphasis added)

Therefore, the relevant period of delay in issuing the patent began on July 29, 2008 and, as of February 18, 2009, our calculations show that the application should receive an additional 205 day term adjustment, for a total of 369 days. Applicants do not know when the application will issue, and therefore respectfully request that the exact term adjustment be recalculated upon issuance.

Applicants did not file a request for continued examination under 35 U.S.C. § 132(b) during prosecution of the instant application. The instant application was never involved in an interference or maintained in a sealed condition under 35 U.S.C. § 181. Applicants did not file a notice of appeal to the Board of Patent Appeals and Interferences under 35 U.S.C. § 134 and 37 C.F.R. § 41.31 for the instant application. The instant application is not subject to a terminal disclaimer. According to Applicants' calculations, there should be no additional deduction from the calculated patent term adjustment based on delay by Applicants.

In accordance with 37 C.F.R. 1.18(e), please charge the \$200.00 fee to our Deposit Account No. 08-0219. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 08-0219.

Respectfully submitted,



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Date: February 18, 2009

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